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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,604	06/15/2000	HIROKAZU TANAKA	1217-001125	9815

7590

07/25/2002

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436 SEVENTH AVENUE  
PITTSBURGH, PA 15219-1818

EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-9

**Advisory Action**Application No.  
**09/581,604**Applicant(s)  
**Tanaka et al.**Examiner  
**Sheeba Ahmed**Art Unit  
**1773**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 19, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached sheet.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None

Claim(s) objected to: None

Claim(s) rejected: 1-12

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other:

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### **DETAILED ACTION**

1. The Amendment After Final rejection submitted on June 19, 2002, has been entered on the record but does not place the Application in condition for allowance.

Applicants traverse the 103 rejection over Kayanoki and assert that although there are no data points in the Comparative results given in the Specification towards the lower weight ratio of 0.0005, all indications are that the composition produces the desired effects at the lower weight ratio value claimed. Applicants further state that the lowest claimed weight ratio of 0.0005 is difficult to control and is not practical. However, the Examiner maintains her position that such a showing is not commensurate with the scope of the claimed weight ratio of the iron oxide to the titanium oxide (i.e., 0.0005 to less than 0.005) in the composite particles of the hard coat composition. The results set forth in Example 1 and Comparative Example 1 compare a weight ratio of 0.002 to 0.02 and indicate that the hard coat film of Example 1 is free from photochromism and has excellent weather resistance whereas the hard coat of Comparative Example 1 does not. The range of data exemplified in the showing is not commensurate with the entire range claimed. Specifically, there are no data points towards the lower weight ratio of 0.0005 and hence it is not clear what indication the Applicants have that the composition produces the desired effects at the lower claimed weight ratio.


Applicants further argue that the composite of Terasse is a mixture of metal oxide particulates and silica agglomerates and not the composite oxide of the present invention and that Terasse is published after the priority application of the present invention was filed and hence is


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not applicable prior art. First, the Applicants have failed to clearly point out the difference between the claimed invention and the agglomerates disclosed by Terasé. The Examiner maintains that Terasé does pertain to the composite oxide of the present invention since a composite is simply defined as "a solid material having two or more substances having different physical characteristics and in which each substance retains its identity while contributing desirable properties to the whole". Second, the Examiner would like to point out that Terasé is *not applied prior art* but is simply used as *evidence* to show that it is known that the weight ratio of various metal oxides and silica can be varied to obtain varying properties. For example, UV shielding function can be imparted to a composite material by varying the amount of titanium oxide, zinc oxide and iron oxide. Hence, the above rejection is maintained for the reasons of record.

### ***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

 Sheeba Ahmed  
July 23, 2002

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700